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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/921,351 | 08/02/2001 | Uwe Werner Ehling | BATG-6 | 6032 |

27868 7590 10/28/2002

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| EXAMINER |
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WALLS, DIONNE A

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| ART UNIT | PAPER NUMBER |
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1731

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DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/921,351 | EHLING ET AL. | |
| | Examiner | Art Unit | |
| | Dionne A. Walls | 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4-6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-5 are, drawn to a method for conditioning comminuted tobacco material, classified in class 131, subclass 306.
 - II. Claims 6-31, drawn to a device for conditioning tobacco material, classified in class 131, subclass 306.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as adding moisture to foodstuffs.
2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. John Salazar on Wednesday, October 23rd, 2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 6-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 6 recites the limitation "the upper inlet" and "the lower outlet" in line 4. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 9 recites the limitation "the discharge direction" in line 1. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 10 recites the limitation "said discharge direction" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-10, 15-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigutsch et al (US. Pat. No. 6,158,441) in view of WO 87/07478.

Grigutsch et al discloses an apparatus for increasing to specific volume of particulate tobacco material wherein said material contacted with water and steam in a chamber having an inlet 210 in which tobacco is entered into the chamber, and an outlet 218 in which tobacco is exited. Cell wheels 217 are located at both the entrance and exits. Nozzles 214 are provided between the entrance and exit to deliver atomized particles of water or a suitable moisturizing agent (corresponding to the claimed "water vapor") to the tobacco particles as they are delivered into the middle of the chamber. Steam can also be delivered to the tobacco particles at the exit of the chamber.(see cols. 1, 5-9 ; fig. 4). While Grigutsch et al may not specifically state that the cellular wheels are formed as "pressure differential proof sluices such that hyperbaric pressure of more than 1 bar is maintained in the chamber", WO 87/07478 does disclose an apparatus for expanding tobacco (i.e. increasing the specific volume of tobacco particles) wherein steam is supplied, up to 155 degrees C and at 4 bar, to said tobacco in a vessel which maintains the pressure within the vessel due to the fact that the inlet and outlet means consist of steam locks which comprise cell wheels and a device called

an arrester (see page 2 and abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Grigutsch et al such that the chamber can be operated under pressure, by replacing the cell wheels with the cell wheel/arrester/surplussing valving means combination of WO 87/07478 so as to provide cell wheels which are essentially "pressure differential proof" means which, based on WO 87/07478, obviously provide for an improved chamber wherein the expanding of tobacco can efficiently and effectively occur.

Regarding claim 7, since the nozzles 214 appear to be located on at least three locations of the chamber, which is assumed to be cylindrical in shape, it follows that the nozzles could be considered "ring nozzles" since they are positioned on a cylinder (i.e. ring) which comprises the chamber wall.

Regarding claim 8, while there is no specific articulation in the written specification of the structure of the nozzles 14, as evident in the drawings, it appears that the nozzles 14 are flush with the inner surface of the chamber; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to fabricate the nozzles in this manner in order to prevent interference of the cascading of the tobacco particles through the chamber.

Regarding claim 10, the discharge direction articulated in the claims is not deemed to patentably distinguish the claim from the Grigutsch et al reference since the 90 angle in which the nozzles are oriented would have been an obvious modification to one having ordinary skill in the art after endeavoring to optimize the angle of the nozzles to provide the most effective delivering of conditioning material to the falling tobacco .

Regarding claim 15, while the apparatus exemplified in Fig. 4 which has two cell wheels located at the entrance and exit of the chamber may not be disclosed as also having an airflow dryer connected to the lower cell wheel, Grigutsch et al suggests such an arrangement when it states tat the dryer constitutes and optional but highly desirable feature of the apparatus (col. 8, lines 26-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add an airflow dryer, in lieu of the conveyor 224, to the apparatus embodied in Fig. 4 in order to ensure that the achieved state of an increase of specific volume is preserved/stabilized as expeditiously as possible.

12. Claims 11-12, 20,25-27, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigutsch et al (US. Pat. No. 6,158,441) in view of WO 87/07478, and further in view of Bichsel (US. Pat. No. 6,221,413).

While the device of Grigutsch et al and WO 87/07478 may not teach of a heating jacket provided with the chamber, Bichsel discloses a device for expanding material which includes a heat jacket (see fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add a heating jacket to the device of Grigutsch et al modified by WO 87/07478 in order to maintain the temperature of the contents within the chamber, as is known and evidenced by the disclosure in Bichsel.

Regarding claim 12, 25-27, 29 and 31 the recitation "said heating jacket is heated using a vapor" and "the vapor source is superheated vapor having a temperature of about 100-200 degrees C" does not patentably distinguish the claims from the reference

since it fails to further limit the claims "structurally", and said claims are drawn to an apparatus. See MPEP 2114. However, Bichsel does disclose that the jacket is heated by a water vapor agent which may be heated to about 180 degrees C (col. 6, lines 9-12; see fig. 2).

13. Claims 13-14, 23-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigutsch et al (US. Pat. No. 6,158,441) in view of WO 87/07478, and further in view of Hibbitts et al (US. Pat. No. 4,253,474).

While Grigutsch et al modified by WO 87/07478 may not disclose that the chamber expands in an approximately tapered manner downwardly, Hibbitts et al discloses an apparatus for expanding tobacco which is slightly tapered outwardly from an upper vessel location to a lower vessel location (see fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Grigutsch et al modified by WO 87/07478 such that the chamber tapered outwardly from the upper to lower part of said chamber in order to allow for easy removal of the processed tobacco as taught in Hibbitts (col. 2, lines 35-40).

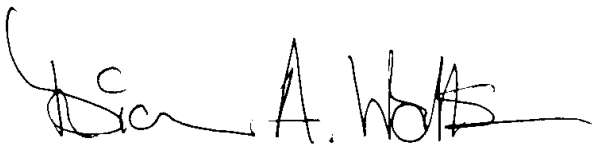
Regarding claims 14 and 23, it follows that if the device of Grigutsch et al modified by WO 87/07478 and Hibbitts et al is tapered outwardly, that would obviously provide for a chamber wherein the lower cell wheel sluice would have a higher conveying volume than the upper cell wheel sluice since the lower cell wheel sluice will be larger in area.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is stylized with a large initial "D" and "A".

Dionne A. Walls
October 26, 2002